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JDI PATENT

Fax

To: Examiner Joseph Martinez USPTO **From:** Dr. Joshua Isenberg

Fax: (571)-272-2335 **Date:** January 26, 2004

Phone: (571-273-2335 **Pages:** 5

Re: Application 09/672,159 **CC:**

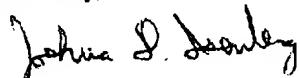
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Comments:

Examiner Martinez. Attached is a proposed response to the Office Action Mailed October 3, 2003. Please confirm receipt of this fax by email to josh@jdipatent.com.

Let me know when we can discuss this with you and your primary or supervisor.

Sincerely,



Joshua D. Isenberg
Patent Attorney, Reg. No. 41,088

THURS C 1:00 PM EST

408-435-9800

IN THE US PATENT AND TRADEMARK OFFICE

Application Number: 09/672,159
5 Attorney Docket Number AFC-005
Filing Date: September 27, 2000
Applicant: Benjamin B. Jian et al.
Application Title: HYBRID MICROLENS ARRAY
Examiner: Joseph P. Martinez
Art Unit: 2873

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15 Commissioner of Patents and Trademarks
Washington, DC 20231

Sir:

In response to the Office Action mailed October 3, 2003 (paper no. 15), kindly consider the following remarks:

20 **REMARKS** begin on page 2 of this amendment.

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Reply to Office Action of October 20, 2003

Attorney Docket No.: AFC-005

REMARKS:

SUMMARY OF THE OFFICE ACTION AND THIS RESPONSE

In the outstanding Office Action, Claims **1-8, 16-18, 21-27** and **41-52** were rejected only under 35 USC 103(a) as being unpatentable over Kravitz in various combinations with other references. The Applicant respectfully traverses these grounds of rejection as set forth below.

CLAIM REJECTIONS UNDER 35 USC 103

The Examiner has rejected claims **1-8, 16-18, 21-27** and **41-52** under 35 USC 103 as being obvious over US Patent 5,790,730 to Kravitz et al. (hereinafter Kravitz) in view of U.S. Patents 5,846,638 to Meissner (herein after Meissner), 5,195,150 to Stegmuller (hereinafter Stegmuller), 5,200,010 to Funami (hereinafter Funami) and 5,449,630, to Lur (hererinafter Lur). In response, the Applicant submits that the Examiner's rejection does not establish a prima facie case of obviousness for the reasons set forth below.

The Fact That The Teachings Of The Kravitz Can Be Combined Or Modified Is Not Sufficient To Establish *Prima Facie* Obviousness

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. For example, in *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed.Cir.1990) claims were directed to an apparatus for producing an aerated cementitious composition by driving an output pump at a capacity greater than the feed rate in order to draw air into the composition. The prior art reference in *Mills* taught that the feed means could be run at a variable speed. However, the court found that this does not require that the output pump be run at the claimed speed so that air is drawn into the mixing chamber and is entrained in the ingredients during operation. The court concluded that although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." 916 F.2d at 682,16 USPQ2d at 1432).

A situation analogous to *Mills* exists in the present case. Here, the Kravitz reference teaches that the first layer 30 and second layer 32 can be made of different materials. The Examiner argues that because Kravitz teaches that silicon and glass may be used as in the layers 30 and 32, the

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Examiner interprets these as meaning that Kravitz teaches that the second layer can have a higher refractive index than the first. However, the Applicants submit that these teachings of Kravitz do not require that the second layer have a higher refractive index than the first. The Examiner's argument is analogous to arguing that a teaching of a variable feed rate is equivalent to a teaching that an output pump can be run at a capacity greater than the feed rate. Even if, arguendo, the apparatus of Kravitz could be modified, the Examiner has pointed to no teaching or suggestion in either Kravitz or Meissner or any other reference that the apparatus of Kravitz be modified to operate as claimed. Absent such a showing in the prior art, the Examiner has impermissibly used the Applicants teaching to hunt through the prior art for the claimed elements and combine them as claimed. (see *In re Vaeck*, 947 F. 2d 488, 20 USPQ 2d 1438 (Fed. Cir. 1991); *In re Bond*, 910 F. 2d 831, 15 USPQ 2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 871 F. 2d 115, 117, 10 USPQ 2d 1397, 1398 (Fed. Cir. 1989)). As such, a *prima facie* case of obviousness is not present with respect to the pending claims.

**15 The Examiner Has Cited No Teaching Supporting His Interpretation Of Kravitz with
Respect to Lens Sag and the Sum of the Two Layer Thicknesses**

The Examiner has interpreted the teachings of Kravitz in Fig. 5b as disclosing the functional attributes of the lens sag and sum of the two layer thicknesses. However, the Examiner has not pointed to any specific teaching or suggestion in Kravitz supporting this interpretation. Nor has the Examiner pointed to any teaching or suggestion in Kravitz or any of the other cited references that it would be desirable to reduce the lens sag and the sum of the layer thicknesses. Nor has the Examiner pointed to any teaching or suggestion that making the second layer with a higher refractive index than the first would accomplish this. Absent such a showing in the prior art, the Examiner has impermissibly used the Applicants teaching to hunt through the prior art for the claimed elements and combine them as claimed. As such, for the reasons set forth above, a *prima facie* case of obviousness is not present with respect to the pending claims.

Furthermore, none of the cited references teach the problem solved by the invention or its source. Specifically, no cited reference teaches *the desirability of reducing the lens sag and the sum of the two layer thicknesses*. The Applicants submit that reducing the overall thickness and lens sag is desirable for several reasons, such as much improved manufacturability of refractive lenses

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with large diameters and large numerical apertures (see, e.g., page 6, line 24 to page 7, line 7 of the present application). In particular, refractive lenses with large diameter and low aberration are desirable for dual fiber collimators (see e.g., page 1 to page 2 line 18). Kravitz, by contrast simply does not mention dual fiber collimators or any other reason for desiring large diameter, 5 low lens sag, low-thickness lenses. It is well established that a patentable invention may lie in the discovery of a problem even though the remedy may be obvious once the source of the problem is identified (see, e.g., *In re Sponnoble* 56 CCPA 823, 832, 405 F.2d 578, 585, 160 USPQ 237, 243 (1969) and *In re Peehs*, 612 F.2d at 1290, 204 USPQ at 837 (CCPA 1980)). In Peehs, the Federal Circuit reversed a Patent Appeals board that had found obvious claims to a 10 nuclear fuel rod with a roughened end. The Federal Circuit found it particularly relevant that the cited prior art did not address the sticking and stressing problems that the claimed invention was designed to eliminate (612 F.2d at 1289). Here, the cited art does not address the problem of manufacturing large diameter, low lens sag, low-thickness lenses for dual fiber collimators or any other reason. As such, the Examiner has not established a *prima facie* case of obviousness.

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CONCLUSION

For the reasons set forth above, the Applicant submits that all claims are allowable over the cited art and define an invention suitable for patent protection. The Applicants therefore respectfully request that the Examiner enter the amendment, reconsider the application, and issue a Notice of Allowance in the next Office Action.

20 Respectfully submitted,

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